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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,161	06/25/2004	Shin-ya Matsunaga	1155-0279PUS1	7426
2292 7590 06/26/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PENG, KUO LIANG	
			ART UNIT 1712	PAPER NUMBER
			NOTIFICATION DATE 06/26/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/500,161

Applicant(s)

MATSUNAGA ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/19/07 Response.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,17 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,17 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicants' response filed April 19, 2007 is acknowledged. Now, Claims 16-17 and 22-27 are pending.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102 and 103

3. Rejection of Claims 16-17, 22 and 24 under 35 USC 102(b) as being anticipated by Hakuta407 (WO 01/98407, US 6 743 862), rejection of 23 and 25 under 35 USC 103(a) as being unpatentable over Hakuta407, optionally in view of Kakuta251 (WO 00/55251, US 6 864 315) and rejection of 26-27 under 35 USC 103(a) as being unpatentable over Hakuta407 in view of Kakuta251 are maintained because the rejection is adequately set forth in paragraphs 3 and 6-7 of Paper No. 012007. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The following column and line numbers are based on Hakuta407's U.S. equivalent, US 6 743 862.

For Applicants' argument (Remarks, page 3, 2nd to 4th paragraphs), Applicants are reminded that the weight ratio (A)/(B) can be **100:0**. Note that even without the organopolysiloxane, Hakuta407's composition is liquid injection molded as explained in the previous Office action (Paper No. 012007).

For Applicants' argument (Remarks, page 4, 1st and 2nd paragraphs), Examiner disagrees. Examiner is not able to find a basis in Applicants' specification that the claimed SiH group-containing compound (C) **must** be a liquid. Nonetheless, Hakuta407's Si-H group-containing compound (B) can be 1,1,3,3-tetramethyldisiloxane, etc. (col. 11, line 61 to col. 12, line 2), which is a **liquid**. Hakuta407's ethylene/ α -olefin/non-conjugated polyene random copolymer can have an intrinsic viscosity described in col. 8, lines 56-60, which reads on the claimed intrinsic viscosity. As such, the random copolymer should be **liquid**. *In re Best*, 195 USPQ 430 (CCPA 1977).

For Applicants' argument (Remarks, page 7, 4th paragraph to page 8, 4th paragraph), Examiner's positions set forth above are applicable here.

4. Rejection of Claims 16-17 and 22-27 under 35 USC 102(b) as being unpatentable over Hakuta251 (WO 00/55251, US 6 864 315) is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 012007. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 5, 2nd paragraph and page 7, 2nd paragraph), as mentioned in the previous Office action (Paper No. 012007), the intrinsic viscosity of the ethylene/ α -olefin/non-conjugated polyene random copolymer can be as low as **0.3 dl/g** (col. 21, lines 35-54) that is very close to the claimed value of **less than 0.3 dl/g**. Furthermore, Hakuta251 teaches that in general a **decrease** in the **viscosity** of a composition is **desirable**. The motivation is to enhance the processability thereof. (col. 2, lines 24-38) Note that the viscosity of component A) can ultimately affect that of the composition. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize component A) having the claimed intrinsic viscosity in order to afford a composition with a desired viscosity with expected success. Especially, Applicants do not show the **criticality** of the claimed viscosity. Applicants are further reminded that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close

enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)

For Applicants' argument (Remarks, page 6, 2nd paragraph), Examiner is not able to find the support for using a non-liquid copolymer as the preferred embodiments taught by Hakuta251. Even if there were such a support, they are merely preferred embodiments. Hakuta251 certainly does not exclude the use of a liquid copolymer.

For Applicants' argument (Remarks, page 6, last paragraph), it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize component A) having the claimed intrinsic viscosity in order to afford a composition with a desired viscosity with expected success, *supra*.

For Applicants' argument (Remarks, page 7, 1st paragraph), Examiner disagrees. Hakuta251 teaches that if the filler causes too much increase of the viscosity, the viscosity of the composition needs to be decreased for the sake of processibility. Thus, as a whole, Hakuta251 teaches the desire to lower the viscosity. Therefore, the rejection is adequate. Especially, Applicants do not show the **criticality** of the claimed viscosity.


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
June 20, 2007


Kuo-Liang Peng
Primary Examiner
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